

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID C. FALLSIDE, JOHN B. IBBOTSON, and
ANDREW J. STANFORD-CLARK

MAILED

AUG 31 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-1702
Application No. 09/583,479

ON BRIEF

Before HAIRSTON, LEVY, and BLANKENSHIP, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a Publish/Subscribe (Pub/Sub) apparatus and method for optimizing group bulk purchases (specification, pages 1 and 4).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A method for placing a group order, mediated by a system having one or more computers, the method comprising the steps of:

publishing, by a publisher, information about a quantity of a material;

subscribing, via a subscriber, to a topic comprising said information;

receiving, via a subscriber, said information;

aggregating, via a subscriber, said information from at least one of said publishers; and

responsive to said step of aggregating, selecting based on at least one criterion a best time to place said group order.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Walker et al. (Walker) 6,418,415 Jul. 09, 2002
(filed Oct. 03, 1997)

Claims 1-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Walker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed January 23, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed November 12, 2003) and reply brief (filed March 29, 2004) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the

examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We turn to the rejection of claims 1-13 as being anticipated by Walker. We begin with claim 1.

The examiner (answer, page 5) provides us with a one-to-one correspondence between claim 1 and the disclosure of Walker.

Appellants' position (brief, page 4) is that the system disclosed in Walker is in accordance with the prior art cited in the application, specifically U.S. Patent No. 6,047,266 to Van Horn, and that Walker, like Van Horn, differs substantially from the claimed invention. Appellants assert (brief, page 6) that step 1304 of Walker does not show "subscribing." It is argued that this disclosure of Walker has nothing to do with any publish/subscribe model in that all the buyer is doing is sending a conditional purchase order (CPO) directly to a vendor, and that there is no mediation by any publish/subscribe system taught or suggested by Walker. Appellants further assert (id.), that step 1344 of Walker does not show aggregating requests from multiple buyers, and that this portion of Walker shows an order being processed individually, not in response to an aggregation

of orders from a buyer. Appellants additionally assert (brief, pages 6 and 7) that step 1410 of Walker does not teach or suggest a step of publishing because in this process, all that the buyer of Walker is doing is sending an acceptance directly to a vendor. Appellants add (id.), that there is no mediation by any publish or subscribe system taught or suggested.

Appellants additionally assert (brief, page 7) that:

The claimed invention specifically and clearly claims the publish and subscribe technique of the present invention, and the claimed invention is easily adapted to a repeating bulk product replenishment or bulk market removal service market. Walker is devoid of any such teaching.

The examiner responds (answer, page 3) that the seller's registration is subscribing, and that step 1318 (see also figures 13A-14B) shows aggregation. The examiner adds (id.) that central controller 200 publishes aggregate CPOs and that step 1405 places a group order in response to the aggregation.

In the reply brief, appellants assert (page 1) that the source of disagreement between appellants and the examiner revolves around the well known concept of pub/sub technology, and that as part of the pub/sub process, a pub/sub mechanism mediates the matching of buyers and sellers.

Before addressing the examiner's rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline
Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim 1 to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claim, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ

697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with

the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988).

What we are dealing with in this case is the construction of the limitations recited in the appealed claims. As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that the phrases publish/subscribe or publish/subscribe mechanism do not appear in the claim (or in any of appellants' claims). The only reference to mediation in the claim is in the preamble, which recites, inter alia, "placing a group order, mediated by a system having one or more computers." Although we give weight to the preamble because the group order is also referred to in the body of the claim, the claim does not set forth which steps (or any or all steps) are mediated by a computer system. There is no disclosure in the

claim of any pub/sub mechanism mediating the matching of buyers or sellers. In fact, the terms buyer or purchaser or seller do not appear in the claim. Moreover, the claim does not recite that the publishing and subscribing are done by programs. Nor is there any statement in the claim as to how the selecting is done, other than it is via a subscriber, as noted by the examiner (answer, page 5). In sum, although we find the claim to be definite, we also find the claim to be very broadly worded, and we decline to read into the claim limitations not found therein. We observe that independent claim 8 is broader than claim 1 as claim 8 makes no mention whatsoever of mediating.

Turning to Walker, we find, as noted by appellants (brief, page 4) that the reference is directed to "an aggregate conditional purchase offer (CPO) management system for receiving and processing CPOs from buyers for one or more goods or services." Further, appellants state

Received CPOs are processed to determine whether the CPO should be provided to sellers individually and/or collectively as part of an aggregate CPO. If a CPO is accepted individually, or collectively as part of an aggregate CPO, the buyer is bound on behalf of the accepting seller. CPOs are administered on behalf of groups of buyers to form aggregate CPOs which are offered to sellers.

Thus, we agree with appellants (reply brief, page 3) that Walker is not directed to a publish/subscribe system. Accordingly, the issue becomes whether appellants' claim 1, as broadly worded, is anticipated by the disclosure of Walker in a manner unintended by appellants.

From our review of Walker, we find that Walker (col. 1, lines 17-20) is directed to:

a system for managing the sale of goods and services by one or more sellers to a group of buyers who have submitted purchase offers for the purchase of such goods and services.

From the disclosure of Walker (col.2, lines 57-64) that an aggregate conditional purchase offer (CPO) management system receives and processes individual CPOs from buyers for one or more goods and services; that the CPOs are provided to sellers, and the disclosure (col. 6, lines 48-50) that CPO management system 100 can provide a CPO to each appropriate broadcast-based seller) we find that Walker discloses publishing (providing to sellers), by a publisher (central controller; see also col. 15, lines 20 and 21) information about a quantity of material (the buyer's requested goods or services). Accordingly, we agree with the examiner (answer, page 5) that the central controller 100

meets the claimed publisher. From the disclosure (col. 9, lines 18-21) that:

The seller database 600 preferably stores information on each seller which is registered with the aggregate CPO management system 100 to sell goods or services to CPO buyers

we agree with the examiner (answer, page 5) that Walker discloses subscribing, via a subscriber (CPO management system), to a topic covering said information. Because the seller subscribes by registering with the system, the subscribing clause is met. From the disclosure (col. 3, lines 8-10) that the aggregate CPO management system administers individual CPOs on behalf of groups of individual buyers to form aggregate CPOs, we find that Walker discloses aggregating, via a subscriber (CPO management system) information from at least one publisher (central controller 100). In addition, from the disclosure (col. 5, lines 25-31) that:

In a further variation, the aggregate CPO management system 100 can request a buyer to modify the original terms of a CPO to conform the terms to an existing aggregate CPO or one or more pending individual CPOS, so that the modified CPO can be included with the pending aggregate CPO or the pending individual CPO(S) to form a new aggregate CPO


we find that Walker teaches that the system for providing a group price for buyers mediates using one or more computers. We additionally find that upon receiving an aggregate CPO from the

CPO management system, the CPO management system, or the seller, makes a determination to select the CPO and bind the buyer (col. 15, lines 31-34 and col. 6, lines 57-63 and col. 2, lines 64-67). Because the selecting process occurs as a result of the aggregated CPOs being provided to the sellers, we find that this teaching of Walker meets the claimed "responsive to said step of aggregating, selecting" a CPO. However, the claim requires more. Claim 1 requires that a best time to place the group order is selected. The examiner's position (answer, page 5) is that time and price are part of the aggregation conditions. The examiner is correct that price and expiration time are part of the aggregation conditions (col. 11, lines 24-32). However, although expiration time is a CPO parameter, there is no disclosure in Walker of selecting a best time to place the order. Accordingly, we find that the teachings of Walker fail to establish a prima facie case of anticipation of claim 1. The rejection of claim 1 under 35 U.S.C. § 102(e) is therefore reversed. Turning to independent claim 8, we reverse the rejection of claim 8 because claim 8 also requires selecting a best time to place said group order. Therefore, the rejection of claims 1-13 under 35 U.S.C. § 102(e) is reversed.

To summarize, the decision of the examiner to reject claims 1-13 under 35 U.S.C. § 103 is REVERSED.

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KENNETH W. HAIRSTON
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

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